

REMARKS

Claims 1-44, 47, 48 and 51 are pending. Claims 1-44, 46-48, and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,721,784 B1 to Leonard, et al. (“Leonard”), in view of U.S. Patent No. 6,272,484 B1 to Martin, et al. (“Martin”).

Reconsideration is requested. The rejections are traversed. No new matter is added. Claims 1, 14, 20, 21, 23, and 42 are amended. Claims 5, 18, 19, 43, 45, 49-50 are cancelled. Claims 1-4, 6-17, 20-42, 44, 46-48, and 51 remain in the case for consideration.

The amendments to the claims introduce features that were previously recited in other claims. Specifically, the amendment to claim 1 introduces the feature previously recited in claim 5, the amendment to claim 14 introduces features previously recited in claims 18-20, and the amendment to claim 42 introduces the feature previously recited in claim 43. Consequently, the amendments to the claims do not require further search.

Claim Rejections - 35 U.S.C. § 103

Claims 1-44, 47, 48, and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,721,784 B1 to Leonard, et al. (“Leonard”), in view of US Patent No. 6,272,484 B1 to Martin, et al (“Martin”). The applicant traverses the rejections.

Leonard teaches a system and method for enabling the originator of an electronic mail message to preset an expiration time, date, and/or event, and to control and track processing or handling by all recipients. *See* Leonard, Abstract. Leonard uses message origination software to create an email message, and FIGs. 1 and 6-8 show that the message origination software can be integrated with a viewer applet to view the message. By integrating the message origination software with the viewer applet, Leonard allows users to enable and disable message controls and features for viewing the message.

Leonard further teaches integrating the origination software with the viewer applet in column 18, lines 53-55 saying, “the viewer and origination software are combined into a single program.” Although Leonard teaches software with an origination component and a viewing component integrated together, Leonard does not teach a viewer applet contained with the message itself in a single file. Indeed, column 14, lines 51-55 describes “retaining the message on the electronic mail server and requiring the recipient to view the message using the viewer applet”. Later in column 14, lines 60-63, Leonard says that the viewer applet retains only “transient storage of the message. Since the message exists only on server 1...” This reference to transient storage of the message should make it clear that the applet is not part of the message

itself. Rather, Leonard is clear in that a message is not transmitted to the user with the viewer applet, but instead the viewer applet is used to allow the viewer to view the message that is stored on the electronic mail server.

Leonard states:

The basic concept underlying this embodiment of the invention is to control viewing and handling of the electronic mail message by retaining the message on the electronic mail server [1] and requiring the recipient to view the message using the viewer applet 4, which permits only the functions indicated by the originator of the message. Use of the viewer to view the message is ensured by encrypting the message and transmitting the message to the viewer applet, with only the viewer applet having the ability to decrypt the message, and the viewer applet retaining only transient storage of the message.

Leonard column 14, lines 51-61. This passage not only shows that the viewer applet and the message of Leonard are not packaged into a single file, but it also explains why: it is so that the viewer is needed to decrypt the message. Without the viewer, the message cannot be viewed (as it is encrypted).

Martin teaches a method and apparatus for managing electronic documents in which a document can be selected from a webpage, thereby causing an image file of the document to be saved locally. *See* Martin, Abstract. This allows an image of the webpage to be viewed without viewing the original website.

Martin states:

In another embodiment, data of the stored image file is copied and combined with executable viewer code to form a self-contained executable program to view the image data of the stored image file. It is appreciated that the self-contained executable file may be provided to another user to enable that user to view the stored image file even if the other user does not have software with the ability read the stored image file.

Martin column 9, lines 21-29. This passage of Martin makes clear that in this described embodiment, the image file contains both an image and an executable viewer, such that the image file can be viewed without separate software.

In contrast to both Leonard and Martin, the present application discloses a rich media file that includes both information and a viewer in a single file such that when the file is deleted, no footprint is left on a recipient's system. *See* Specification, page 2, lines 12-17.

Regarding the 35 U.S.C. § 103 rejections, the Examiner has failed to establish *prima facie* obviousness for the rejected claims because there is no suggestion or motivation for the combination of Leonard and Martin. MPEP 2143.01(V) states "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose,

then there is no suggestion or motivation to make the proposed modification.” As described above, it is a “basic concept” of the Leonard invention that a message and a viewer applet exist separately. The message is encrypted and can only be decrypted by the viewer applet. This ensures that the originator has control over deletion of the message. *See* Leonard, column 14, line 61 through column 15, line 6.

Combining the self-executable image file of Martin with the message of Leonard would render Leonard’s invention unsatisfactory for its intended purpose. If the message of Leonard included the viewer code as taught by Martin, there would be no need for the (separate) viewer applet. But if the viewer code is included with the message, then anyone who receives the message automatically receives the viewer code, and is therefore able to view the message. The encryption of Leonard, used to prevent persons without the proper viewer from viewing the message, is rendered pointless.

Further, the ability to completely expunge the message is a “basic concept” of the Leonard invention. But if the message includes the viewer code, then the file containing the combined message and viewer code can be stored indefinitely on the recipient machine. This means that the originator of the message loses the capability of completely expunging the message: copies of the message could be stored on any number of computers, on which the originator has no ability to delete the message.

Since the combination of Leonard and Martin would make Leonard unsatisfactory for its intended purpose, there is no motivation to combine the references as suggested by the Examiner. Since this combination forms the basis of all rejections in this Office Action, the Examiner has failed to make a *prima facie* argument that the claims are unpatentable under 35 U.S.C. § 103(a) over Leonard in view of Martin, and the claims should therefore be allowable.

Despite the lack of *prima facie* obviousness as discussed above, the applicant presents amendments to the claims in the interest of moving this case toward allowance.

Regarding claim 1, the claim has been amended to include the limitations of original claim 5, so that claim 1 is now equivalent to previous claim 5. Amended claim 1 recites that a rich media file comprises checking means for checking if there is a later version of the rich media file. Although Leonard does teach that its central mail server tracks versions of an email message (*see* Leonard, column 13, lines 32-55), Leonard does not teach that its email message includes a checking means for checking if there is a later version of the email message. Martin does not teach that its electronic document has any versions, and so does not remedy

the deficiency of Leonard. For at least this reason, claim 1 and dependent claims 2-4 and 6-12 are allowable over the combination of Leonard and Martin.

Regarding claim 13, the claim already contains the limitation of a checking means, discussed above with respect to claim 1. Consequently, claim 13 and dependent claim 51 are also allowable over Leonard in view of Martin.

Regarding claim 14, the claim has been amended to include the limitations of previous claims 18, 19, and part of 20. As discussed above with respect to claim 1, the combination of Leonard and Martin does not teach checking means for checking if there is a later version of the rich media file. Consequently, claim 14 and dependent claims 15-17 and 20-25 are allowable over the combination of Leonard and Martin.

Regarding claim 26, the claim recites a unitary rich media file designed to leave no footprint on a user's system when removed. Leonard does not teach that its email message/viewer applet leaves no footprint on a user's system when removed. Further, deleting the email message of Leonard still leaves the viewer applet on the user's system, which is exactly one of the drawbacks of the conventional methods that the present application was designed to avoid. *See* Specification, page 1, line 30 to page 2, line 2. The Examiner proposes that Martin teaches this feature at column 7, lines 16-30. *See* Office Action, page 9, lines 21-22. However, this portion of Martin says nothing about deleting files and leaving no footprint. Instead, this portion of Martin discusses how images of electronic documents can be saved as thumbnails. Nothing else in Martin teaches the claimed feature. Consequently, claim 26 and its dependent claims, 27-41, are allowable over the combination of Leonard and Martin.

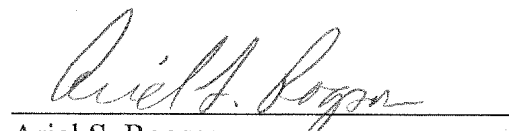
Regarding claim 42, the claim has been amended to include the limitations of previous claim 43, so that claim 42 as amended is now equivalent to previous claim 43. Amended claim 42 recites that a memory includes a client identification for a client creating a rich media file. The Examiner proposes that this feature is taught by Leonard at column 10, lines 56-67. *See* Office Action, page 13, lines 1-3. To the contrary, this portion of Leonard teaches that a header of an electronic mail object includes "the date the message was created, the time that the message was sent, the sender, a title or name of the message, and other information about the document." Leonard column 10, lines 56-67. None of these attributes included in the header of Leonard are a client identification for a client creating a rich media file, as recited in claim 42. Martin does not teach that its electronic documents contain source client identification and so Martin does not remedy the deficiency of Leonard. Consequently, claim 42 and dependent claim 44 are allowable over the combination of Leonard and Martin.

Regarding claim 46, the claim recites that a memory comprises a profile of a user who downloaded a rich media file and a client who generated a rich media file. The Examiner points to Leonard column 12, lines 50-67 and column 14, lines 1-67 as teaching these features. *See* Office Action, page 13, lines 14-15. However, neither of these sections teaches a profile of a user downloading a file or a client who generated the file, nor are these features taught anywhere else in Leonard. Martin does not remedy this deficiency. Consequently, claim 46 and dependent claims 47-48 are allowable over the combination of Leonard and Martin.

For the foregoing reasons, reconsideration and allowance of claims 1-4, 6-17, 20-42, 44, 46-48, and 51 of the application as amended is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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A handwritten signature in cursive script, appearing to read "Ariel S. Rogson", is written over a horizontal line.

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